PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

#13/Brief

EX PARTE Hickman et al.

Application for Patent

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FOR: METHOD, APPARATUS, DATA STRUCTURE AND ARTICLE OF MANUFACTURE FOR MONITORING ELECTRONIC MAIL SYSTEMS

CERTIFICATE OF MAILING
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231, on October 16, 2003

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I. REAL PARTY IN INTEREST

The real parties in interest are the inventors.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

III. STATUS OF THE CLAIMS

Claims 1, 2, 8, 10-14 and 18-20 are pending in this application. All claims have been rejected by the Examiner and are the subject of this Appeal.

IV. STATUS OF THE AMENDMENTS

Applicants did not file any amendments after the last rejection by the Examiner.

V. SUMMARY OF THE INVENTION

Convenience is the mother of invention. In this instance, the inventive concept sprung from the daily inconvenience of an inventor having to log onto multiple e-mail systems in order to retrieve all of his e-mail. Since at least some e-mail is of time-importance, it is necessary to regularly check each and every e-mail system at which a user may be receiving e-mail. This can be a time-consuming and frustrating process.

To address this problem, the inventors devised a method for monitoring multiple electronic mail accounts including the acts of: a) obtaining access information for a plurality of e-mail accounts; b) retrieving mail data from the plurality of e-mail accounts; and c) consolidating the mail data from the plurality of e-mail accounts. The polling can be advantageously accomplished in the background while the user is performing other tasks on the computer system. In this fashion, the user needs only to log on to one e-mail account, and have all of his other e-mail accessible in that account in a consolidated fashion.

An apparatus for monitoring multiple electronic mail accounts includes a digital processor, read/write memory coupled to the digital processor, and at least one external communications channel coupled to the digital processor permitting the digital processor to communicate with a plurality of external electronic mail accounts. A poller at least partially

stored in the read/write memory and executable on the digital processor is operative to generate inquiries over the at least one communications channel to the plurality of electronic mail accounts. A data retriever at least partially stored in the read/write memory and executable on the digital processor is operative to receive data concerning mail intended for a designated user from the plurality of electronic mail accounts. A consolidator develops data concerning mail for the designated user from the plurality of electronic mail accounts.

An article of manufacture for monitoring multiple electronic mail accounts includes a machine-readable storage medium; a poller stored in the storage medium and including program instructions to generate inquiries over at least one communications channel to a plurality of electronic mail accounts; a data retriever stored in the storage medium and including program instructions to receive data concerning mail intended for a designated user from the plurality of electronic mail accounts; and a data handler stored in the storage medium and including program instructions to store and retrieve the data concerning mail for the designated user from the plurality of electronic mail accounts.

VI. ISSUES

The issue presented in this appeal is whether the rejection of the pending claims of this application is proper. The issues are more precisely as follows:

A. *Are claims1, 2, 8, 10, 11 and 18-20 properly rejected under 35 U.S.C. §103(a) as being unpatentable over Thompson et al. (U.S. Patent No. 4,935,954)?*

B. *Are claims12-14 properly rejected under 35 U.S.C. §103(a) as being unpatentable over Thompson et al. (U.S. Patent No. 4,935,954) in view of Cooper et al. (U.S. Patent No. 6,052,442)?*

VII. GROUPING OF THE CLAIMS

Applicant proposes four groups of claims to stand or fall together:

A. *Groups for Issue A*

1. Group 1 – Claims 1, 8, 10 and 11

2. Group 2 – Claim 2

3. Group 3 – Claims 18 - 20

B. *Group for Issue B*

1. Group 4 – Claims 12-14

VIII. THE CITED ART

A. Thompson et al.

Thompson et al. teaches an apparatus for automatically polling message service systems in a PBX to obtain messages for a user of the apparatus. The apparatus is a computer attached to the user's telephone connected to a communication switching system. The computer responds to messages from the communication switching system or to an internal real time clock timing out to poll a number of message service systems to obtain messages for the user. The computer automatically performs logon procedures, message access procedures and message deletion procedures with the various message service systems. If the message service system is audio only, the computer generates audio tones and interprets verbal instruction in order to implement the above procedures.

B. Cooper et al.

Cooper et al. teaches an answering machine receives and records both voice and email messages. The answering machine includes a telephone line interface, a modem, a processor, memory for storing the processor software and recording the messages, a speaker, a display and a keypad. When the answering machine detects a ring signal on the telephone line to which it is connected, it answers the call. The answering machine plays an outgoing message for the caller to hear and records the caller's incoming voice message. Periodically or at predetermined times,

the answering machine may check for email messages by calling a service provider. When the service provider answers the call, the answering machine logs in, downloads and stores at least a portion of email messages that have been received. A user can view the display and review the messages. Voice mail messages are played through the speaker, and email messages are provided on the display.

IX. ARGUMENTS

A. *Claims 1, 2, 8, 10, 11 and 18-20 were improperly rejected under 35 U.S.C. §103(a) as being unpatentable over Thompson et al. (U.S. Patent No. 4,935,954)*

Group 1 – Claims 1, 8, 10 & 11

The claims of group 1 stand or fall with independent claim 1 which includes the limitations of: (a) obtaining access information for a plurality of e-mail accounts; (b) retrieving mail data from said plurality of e-mail accounts; and (c) consolidating said mail data from said plurality of e-mail accounts. Not one of these claim limitations can be found in Thompson et al. (hereafter "Thompson").

In Thompson, there is not teaching or suggestion of obtaining access for multiple e-mail accounts. In fact, Thompson. is specifically designed to access a single e-mail account on a PBX system. That is, Thompson discloses a closed, company internal system which does not and need not support multiple e-mail accounts for an employee. For example, with reference to Figs. 7-9 of Thompson:

> If upon execution of decision block 808 of Fig. 8, block 809 was executed, setting bit 512 in poll execute word 501, block 713 of Fig. 7 will at some point in time later give control to the e-mail point routine illustrated in Fig. 9. This routine then polls computer 106 to obtain the messages for PC 110. This polling is done by logging on to computer 106 and obtaining these messages and then creating header information and storing the header information with the remainder of the message. The e-mail polling routine is entered from entry point 901.

That is, only a single e-mail system is polled. There is no hint or suggestion of multiple e-mail systems, retrieving e-mail from multiple systems, or consolidating e-mail from multiple systems. Applicant's invention is simply not contemplated or suggested by Thompson.

Thompson further does not support the possibility of multiple e-mail accounts for a user. The polling table of Thompson's Fig. 5 allows a system administrator to change the polling sequence of a user for various message modalities, e.g. voice mail, e-mail, etc. However, the polling table of Fig. 5 is a pointer-table which does not pass any parameters to a polling routine. That is, the pointer-table of Fig. 5 can only point to a specified polling routine, such as the e-mail polling routine of Fig. 9. The polling routine of Fig. 9 polls only the one, unique, designated e-mail account associated with that routine. Since the polling table of Fig. 5 of Thompson does not include parameters that are provided to the e-mail routine of Fig. 9 that it is being pointed to, it cannot, in any conceivable way, be configured to poll multiple e-mail accounts for a user. That is, from the e-mail routine's point of view, it has no information other than it has been instructed to retrieve "the" e-mail from a single, designated e-mail account.

Stated another way, Thompson's pointer table of Fig. 5 does not contain any parameters or other information that are passed to the e-mail polling routine of Fig 9 that would be required to allow multiple e-mail accounts for a user. Neither does Thompson disclose any kind of reference constant that could be used to distinguish which of the entries in Fig. 5 was traversed. Therefore, it is impossible to determine on a given invocation of the e-mail polling routine of Fig. 9 which of a plurality of e-mail accounts should be used and, therefore, a plurality of e-mail accounts are not contemplated or supported by Thompson's system.

Should the Examiner argue that a separate routine could be written for each new e-mail account, and in that way the pointer points to a new routine that is geared for a new e-mail account, it should be noted that Thompson does not disclose for or enable this functionality. It would be impermissible hindsight for the Examiner to make such an assertion. Furthermore, Thompson does not disclose a plurality of e-mail logon information in his discussion of user interface with reference to Polling Administration Process 218, precluding multiple e-mail accounts for a user.

In stark contrast to Thompson, the present invention solves the major problem of having multiple e-mail accounts, i.e. having to access each e-mail account, one by one, to retrieve all of the e-mail. As noted above, Thompson does not address or even recognize this problem. The Thompson invention operates in a PBX environment, e.g. the PBX communications environment of a large company. There is no reason why a person would have more than one e-mail address in a PBX environment. To do so would only create confusion and, indeed, the system taught by Thompson does not contemplate polling multiple e-mail addresses for consolidation purposes. In fact, Thompson teaches away from the concept of multiple e-mail addresses by its very nature as a PBX system and the inability of his system to support multiple e-mail accounts for a user.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not be based on Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991). *See* MPEP , 2142 and 2143 – 2143.03.

Applicant respectfully submits that the Examiner has not made an even *prima facie* case of obviousness in the rejection of the claims. First, there is no motivation in Thompson to create the claimed combinations. Second, since the Thompson system cannot support multiple e-mail accounts for a user, there cannot not be any reasonable expectation of success. Finally, Thompson does not teach any, let alone all, of the claim limitations. Applicant respectfully submits that the Examiner has engaged in impermissible hindsight, based upon Applicant's own disclosure, in forming his rejections, and respectfully requests that the rejection of the claims be reversed.

Group 2 – Claim 2

Claim 2 is dependent upon claim 1 and is therefore patentable for at least the same reasons as set forth above with respect to claim 1. In addition, there is no teaching or hint in Thompson of either receiving a designation of a plurality of e-mail accounts, or receiving a designation of access protocols concerning the plurality of e-mail accounts. If the PBX system was modified, as suggested by the Examiner, to include multiple e-mail accounts, they would all presumably have the same access protocols. Claim 2 is claiming an embodiment where there are potentially different access protocols for the plurality of e-mail accounts.

Again the Examiner has not made a *prima facie* case of obviousness. Applicant respectfully requests that the rejection of claim 2 by the Examiner should be reversed for this reason as well.

Group 3 – Claims 18-20

Claim 18 is also not properly rejected as being unpatentable over Thompson. As noted above, Thompson does not teach a poller which generates inquiries to a plurality of electronic mail accounts. That is, Thompson's poller only polls a single electronic mail account, because only one electronic mail account per user is supported by Thompson's apparatus. Thompson furthermore does not have a data retriever for retrieving e-mail from a plurality of electronic mail accounts, or a data handler for handling the e-mail from a plurality of electronic mail accounts.

The elements of the claim are simply missing from Thompson, and the Examiner has again not made a prima *facie case* of obviousness. Applicant respectfully requests that the rejections of the claims of Group 3 be reversed.

B. *Claims12-14 were improperly rejected under 35 U.S.C. §103(a) as being unpatentable over Thompson et al. (U.S. Patent No. 4,935,954) in view of Cooper et al. (U.S. Patent No. 6,052,442*

As noted above, Thompson does not teach the consolidation of e-mails from multiple e-mail accounts as claimed by Applicant. Cooper et al. (hereafter "Cooper") does not cure the deficiencies of Thompson, nor is it properly combinable with Thompson.

As noted by the Examiner, Thompson addresses the PBX environment. Cooper, on the other hand, does not work in a PBX environment, as it is directed to a standard answering machine connected to a standard telephone line which is combined with an e-mail retrieval service which also uses the standard telephone line to access a service provider via a modem. Cooper's machine is designed to retrieve e-mail from a single e-mail service provider, i.e. it does not poll two or more e-mail accounts to consolidate the e-mail from such multiple accounts. Cooper simply periodically checks one, dedicated e-mail account and download content to be displayed.

Therefore, neither Thompson nor Cooper address the problem solved by the present invention, nor would they be suitable to practice the present invention. Further, it is improper to combine Thompson and Cooper since Thompson is directed to a PBX environment, and Cooper is directed away from a PBX environment. Still further, even if Thompson and Cooper were combined, they do not include all (or any) of the elements of the claims. For

example, with respect to claim 1, the combined disclosures of Thompson and Cooper do not reach obtaining access information for a plurality of e-mail accounts; retrieving mail data from a plurality of accounts; and consolidating the mail data from the plurality of accounts. Arguments that Thompson and/or Cooper could be modified to practice the claimed invention are unsupported by any prior art reference.

In view of the foregoing, Applicant again respectfully submits that the Examiner has not made a *prima facie* case of obviousness. Applicant respectfully requests that the rejection of the claims be reversed.

X. CONCLUSION

As noted, none of the cited art, either alone or in combination, can be said to anticipate or render obvious the appealed claims. Accordingly, Applicant believes the rejections to be in error, and respectfully requests the Board of Appeals and Interferences to reverse the Examiner's rejections of the claims on appeal.

Respectfully Submitted,
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APPENDIX A - THE APPEALED CLAIMS

1. A method for monitoring multiple electronic mail accounts comprising:

obtaining access information for a plurality of e-mail accounts;

retrieving mail data from said plurality of e-mail accounts; and

consolidating said mail data from said plurality of e-mail accounts.

2. A method for monitoring multiple electronic mail accounts as recited in claim 1 wherein obtaining access information includes:

receiving a designation of a plurality of e-mail accounts; and

receiving a designation of access protocols concerning said plurality of e-mail accounts.

8. A method for monitoring multiple electronic mail accounts as recited in claim 2 wherein said consolidated mail data is stored in a machine-readable memory of a user's system.

10. A method for monitoring multiple electronic mail accounts as recited in claim 8 further comprising:

visually displaying an indication on said user's system that there is at least one message from at least one e-mail account.

11. A method for monitoring multiple electronic mail accounts as recited in claim 10 further comprising visually displaying information concerning at least one message for said user.

12. An apparatus for monitoring multiple electronic mail accounts comprising:

a digital processor;

read/write memory coupled to said digital processor;

at least one external communications channel coupled to said digital processor permitting said digital processor to communicate with a plurality of external electronic mail accounts;

a poller at least partially stored in said read/write memory and executable on said digital processor, said poller being operative to generate inquiries over said at least one communications channel to said plurality of electronic mail accounts;

a data retriever at least partially stored in said read/write memory and executable on said digital processor, said data retriever being operative to receive data concerning mail intended for a designated user from said plurality of electronic mail accounts; and

a consolidator developing data concerning mail for said designated user from said plurality of electronic mail accounts.

13. An apparatus for monitoring multiple electronic mail accounts as recited in claim 12 wherein said at least one external communications channel includes a Local Area Network (LAN).

14. An apparatus for monitoring multiple electronic mail accounts as recited in claim 12 wherein said at least one external communications channel includes a Wide Area Network (WAN).

18. An article of manufacture for monitoring multiple electronic mail accounts comprising:

a machine-readable storage medium;

a poller stored in said storage medium and including program instructions to generate inquiries over at least one communications channel to a plurality of electronic mail accounts;

a data retriever stored in said storage medium and including program instructions to receive data concerning mail intended for a designated user from said plurality of electronic mail accounts; and

a data handler stored in said storage medium and including program instructions to store and retrieve said data concerning mail for said designated user from said plurality of electronic mail accounts.

19. An article of manufacture as recited in claim 18 further comprising:

a controller stored in said storage medium for selectively controlling said poller, said data retriever, and said data handler.

20. An article of manufacture as recited in claim 19 further comprising an input interface stored in said storage medium to provide user inputs to said controller, and a displayer coupled to said data handler and to said controller to selectively display data stored by said data handler.